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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/360,521
Filing Date: July 23, 1999
Appellant(s): RESTLE ET AL.

MAILED
JAN 29 2007
GROUP 1600

Mareesa A. Frederick
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/27/2006 appealing from the Office action
mailed 08/24/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

5,476,649	NAITO	10-1991
6,451,747	DECOSTER	09-2002

WO97/46211 DECOSTER 12-1997

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

Claims 1-32, 34-41 and 43-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Decoster (WO 97/46210, using USPN 6451747 as an English language equivalent) ('747) in view of Decoster (WO 97/46211, English translation) ('211).

The instant invention is directed toward a composition comprising a washing base comprising an anionic and amphoteric surfactant, wherein the ratio of amphoteric:anionic is greater than or equal to 0.1:1, and a conditioner system comprising at least one aminated silicon having an amine number greater than or equal to 0.4 meq/g, and a cationic polymer.

'747 teaches detergent and conditioning hair care compositions comprising, in a cosmetically acceptable medium, a washing base and a conditioning system comprising at least one cationic polymer and a mixture of at least one amine silicone and a grafted silicone polymer. Exemplified is a composition comprising 14 g of lauryl ethersulfate of sodium (anionic surfactant, 14% of composition), 3.2 g cocoyl betaine (amphoteric surfactant, 3.2%), 1.05 g amino silicone, 0.1 g guar gum modified by chloride of 2,3-epoxypropyl trimethylammonium (cationic polymer, 0.1%), and water, wherein the ratio of amphoteric/anionic surfactant is 0.23. For cellulose derivatives containing quaternary ammonium groups, see col. 6, lines 27-35. For cationic polysaccharides, see col. 6, lines 49-56. For quaternary diamonium polymers comprising 0.001-10% of the

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composition, see col. 11, lines 1-5. For compounds of formula (I), formula (IV), and formula (II), and limitation of claims 13-25 and 27-29, see col. 17, line 4-col. 19, line 16. For aminosilicones comprising 0.05-10% of the composition, see col. 19, lines 17-21. For water or an aqueous alcoholic solution as the vehicle, see col. 19, lines 22-24. For ethanol, isopropanol, and butanol, see col. 19, lines 24-25. For fragrances, preservatives, sequestering agents, thickeners, softeners, foam modifiers, dyes, and other adjuvants, see col. 19, lines 36-42. For a process of washing and conditioning keratin fibers, such as hair, see col. 19, lines 62-67. The reference lacks an exemplification of the preferred aminated silicones, the preferred amount of solvent, and a teaching of transparency.

'211 exemplifies a shampoo composition comprising 14 g laurylethersulfate of sodium (anionic surfactant, 14% of composition), 1 g laurylsulfate of ammonium (anionic surfactant, 1%), 4.6 g cocoamidoethyl (N-hydroxyethyl, N-carboxymethyl) glycinate of sodium (amphoteric surfactant, 4.6%), 2.5 g amine silicone with an amine index of 0.5 meq/g (2.5%), 0.1 g guar gum modified by chloride of 2,3-epoxypropyl trimethylammonium (cationic polymer, 0.1%), and water, wherein the ratio of amphoteric/anionic surfactant is 0.3:1. For the washing base comprising 4-50% of the composition, see pg. 6, last paragraph. For perfumes, preservatives, sequestering agents, thickeners, softeners, foam modifiers, coloring agents, moisturizers, anti-dandruff/antiseborrheic agents, vitamins, sun filters, and suspension agents, see pg. 28, 3rd paragraph. For derivatives of cellulose ethers that include quaternary ammonium groups and cationic polysaccharides, see pg. 16 (2) and (4). For cationic polymers of

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formula (a) of instant claim 35, see pg. 20 (10). For cationic polymers comprising 0.001-10%, see pg. 27, 1st paragraph. For ethanol, isopropanol, and butanol, see pg. 28, 1st paragraph. For a process of washing and conditioning keratinic fibers, such as hair, see pg. 29, 3rd paragraph.

It would have been obvious to one of ordinary skill in the art at the time of the invention to substitute the amodimethicone exemplified in '747 for the compounds of Formulas (I), (IV) or (II) of the instant invention because the precise formulas of these compounds are specifically taught by '747 to be aminosilicones useful in the invention taught therein. It is noted that '747 specifically teaches the exact same formulas as instantly claimed. It is specifically pointed out that the repeat unit variables (m and n) are taught in both '747 and in the instant invention to be chosen such that the sum of (n+m) is between 1 and 2000. It is also pointed out that n and m are both taught by '747 to be between 1-1999 and 1-2000, respectively.

It would have been obvious to one of ordinary skill in the art at the time of the invention to exemplify an amodimethicone of Formulas (I), (IV) or (II) of the instant invention with an meq/g of 0.5 because (1) both '747 and '211 teach detergent cosmetic compositions for hair care; (2) both '747 and '211 teach a composition comprising a washing base and a conditioning system wherein the conditioning system comprises at least one cationic polymer and an aminosilicone; and (3) '211 teaches that the aminosilicone should be formulated such that the meq/g is 0.5. One would have been motivated to formulate the aminosilicone to have an meq/g of 0.5 because of an

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expectation of success in preparing a detergent cosmetic composition, as taught by '747.

It would have been obvious to one of ordinary skill in the art at the time of the invention to teach the solvents of '747 as comprising 0.1-20% of the composition because '747 teaches the use of vehicles in general and where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). It is noted that '747 teaches the compositions of the invention disclosed therein may be formulated in a variety of manners, e.g. as liquids more or less thickened, as creams and as gels. Accordingly, it is suggested by '747 that the amount of vehicle used in the formulation of the compositions taught therein is variable and that it would have been obvious to one of ordinary skill in the art to vary the amount of vehicle used in accordance with the formulation desired.

The recitations "detergent and conditioning cosmetic" in claim 1, and "for cleaning or removing make-up from keratinous substances, or for conditioning keratinous substances" in claim 44 have not been given patentable weight because the recitation occurs in a preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process step or structural limitations are able to stand alone. MPEP 2111.02.

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It is noted that a composition and its properties are inseparable. *In re Papesch*, 315 F.2d 381, 391, 137 USPQ 43, 51 (CCPA 1963). Since '747 in view of '211 teach the same composition as instantly claimed, said composition will, obviously, be transparent.

Claims 33 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over '747 and '211 as applied to claims 1-32, 34-41 and 43-47 above, and further in view of Naito et al. (USPN 5476649).

'747 and '211 apply as disclosed above. The references lack 18-methyl-eicosanoic acid and polyalkylene glycols.

Naito et al. teaches 18-methyl-eicosanoic acid as a branched fatty acid that imparts excellent conditioning effects to the hair and prevents the hair from being damaged (Abstract; col. 1, lines 54-67). Polyalkylene glycols are taught as hair care ingredients that impart moisturization and flexibility to the hair.

It would have been obvious to one of ordinary skill in the art at the time of the invention to add 18-methyl-eicosanoic acid and/or polyalkylene glycol, as taught by Naito et al., to the composition of '747 because (1) both '747 and Naito et al. are drawn to compositions for the improvement of hair styling and/or conditioning effects; and (2) '747 teaches that additional agents (e.g. moisturizers) may be added to the composition taught therein. One would have been motivated to combine the agents of Naito et al. to the composition of '747 because of the expectation of success in achieving a hair care

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product that additionally conditions the hair and prevents it from being damaged, and/or imparts moisturization and flexibility to the hair.

(10) Response to Argument

Applicant argues that "Decoster '211 lacks, among other things, an aminated silicone according to the present invention." This argument is not persuasive because Examiner has not argued otherwise. '211 is used, primarily, to show that an aminated silicone in a detergent cosmetic composition for the hair with an meq/g value as instantly claimed is known in the art to be useful therefor. Examiner has relied on '747 to show the aminated silicone as known in the art. Additionally the examiner respectfully points out that in the example of '211 the invention (A) is compared to comparative example (B-an equivalent amine-containing silicone) that is the same amine-containing silicone disclosed in Example 1 of the '747 reference (see Fluid DC 939 of both examples). Thus while the '211 reference has been used primarily to establish the state of the art in regards to meq/g it further utilizes the same amine-containing silicone of '747 as an equivalent and comparative amine-containing silicone.

Applicant argues that a genus does not anticipate all species therein. This argument is not persuasive as it pertains to the instant rejection.

The MPEP states, "To establish a *prima facie* case of obviousness in a genus-species chemical composition situation, as in any other 35 U.S.C. 103 case, it is essential that Office personnel find some motivation or suggestion to make the claimed invention in light of the prior art teachings ... In order to find such motivation or suggestion there should be a reasonable likelihood that the claimed invention would

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have the properties disclosed by the prior art teachings." To accomplish this, the MPEP instructs that "Office personnel should:

- (A) determine the 'scope of the content of the prior art';
- (B) ascertain the 'differences' between the prior art and the claims at issue';
and
- (C) determine 'the level of ordinary skill in the art.'" See MPEP 2144.08.

In the instant case, the scope and the content of the prior art is such that '747 specifically teaches the exact same formulas as instantly claimed. Both '747 and the instant invention teach formulas wherein $(n+m)$ is equal to between 1 and 2000. Both '747 and the instant invention teach that n and m are between 1-1999 and 1-2000, respectively. The only difference between the prior art and the claims at issue is that the instant claims recite a further limitation wherein the amine number is greater than or equal to 0.4 meq/g. Thus, '747 teaches a genus of aminated silicones wherein the amine number could be anything, whereas the instantly claimed invention is a subgenus thereof wherein the amine number could be anything, so long as it is greater than 0.4 meq/g. Accordingly, the instant invention is related to a substantial portion of the invention set forth in '747. Finally, Examiner has relied on '211 to illustrate the level of ordinary skill in the art. '211 teaches the use of aminated silicones for an identical use as those set forth in '747 with amine index between 0.01 and 1 meq/g, generally, and the use of an aminated silicone with an amine index equal to 0.5 meq/g, specifically. See Abstract, p. 5, p.31. It is Examiner's position that '211 suggests the claimed amine index values of an aminated silicone as useful in a detergent cosmetic composition for

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the hair. Therefore, the skilled artisan would have recognized an aminated silicone of '747, possessing an amine index value as claimed, would be useful in the detergent cosmetic composition for the hair. Accordingly, it is Examiner's position that a *prima facie* case of obviousness has been established.

Applicant's arguments that "While example composition A of Decoster '211 is disclosed as having an amine number of approximately 0.5 meq/g, there is no express disclosure that this amine number should be used in all cases or in all applications. Indeed, an amine number as low as 0.1 may be used." This argument is not persuasive because there is no requirement that '211 teach that an amine index value of 0.5 meq/g must always be used. The fact that one of ordinary skill in the art would recognize an aminated silicone with an amine index value of 0.5 meq/g as useful in a detergent cosmetic composition for the hair is sufficient suggestion to render the instant claims obvious over '747.

Applicant's argument that "there is no disclosure that any of the amines containing silicones having formulae distinct from Decoster '211 should have the same or even similar amine numbers, especially when used in compositions distinct from those of Decoster '211." First, it is noted that both '747 and '211 are directed to detergent cosmetic composition for the hair. It is also noted that, as discussed above, '211 is used only to establish the state of the art. To that end, '211 illustrates that aminated silicones with an amine index of 0.01 to 1 meq/g are useful in detergent cosmetic compositions for the hair and that an aminated silicone with an amine index of 0.5 meq/g is specifically known to be useful therein. Furthermore, as to Applicants

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arguments that “the Office attempts to override the apparent preference in [‘747] for amine-containing silicones having an amine number of <0.1 meq/g ...” This argument is not persuasive because the amine index values of ‘747 are within the range as taught to be useful by ‘211. See Remarks filed October 27, 2004, page 4. Accordingly, one of ordinary skill in the art would have recognized the teachings of ‘747 as consistent with those of ‘211 and would have been *further* motivated to look to ‘211 to determine the skill of the art as it pertained to the amine index values of aminated silicones for use in a detergent cosmetic composition for the hair. Furthermore, it is well established that consideration of a reference is not limited to the preferred embodiments or working examples, but extends to the entire disclosure for what it fairly teaches, when viewed in light of the admitted knowledge in the art, to a person of ordinary skill in the art. *In re Boe*, 355 F.2d 961, 148 USPQ 507 (CCPA 1966); *In re Lamberti*, 545 F.2d 747, 19USPQ 279 (CCPA 1976); *In re Fracalossi*, 681 F.2d 792, 215 USPQ 569 (CCPA 1982); *In re Kaslow*, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983).

Applicant’s arguments regarding the transparency of the composition are not persuasive because the transparency of a composition is a property thereof. A product and its properties are inseparable. *In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963).

Applicant’s arguments as they pertain to Naiko et al. are not persuasive. Naiko et al. teaches specifically branched fatty acids and their derivatives as useful in imparting excellent sensation to hair and preventing hairs from being damaged (Abstract, col. 1, lines 54-67). 18-methyleicosanoic acid is exemplified as a fatty acid

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useful therein. Accordingly, it would have been obvious to one of ordinary skill in the art to use 18-methyleicosanoic acid therefor. Simply because Naiko et al. exemplifies numerous branched fatty acids as useful therein does not indicate that it would have been beyond the purview of the skilled artisan to realize that the specifically exemplified branched fatty acid would have been useful. Such an argument would suggest that one of ordinary skill in the art would take nothing from Naiko et al. because there are too many examples.

The applicant's have asserted that '747 teaches away from the claimed invention. The examiner respectfully disagrees. The examiner points out that in the previous office actions of record the examiner has clearly set forth that the amine-containing silicones of the '747 patent are identical to those as claimed by the applicant. The '747 patent is silent in regards to the meq/g component of the compounds and thus fails to **anticipate** the invention as claimed. If applicant's are to assert that the same amine-containing silicone compositions as their own can not have meq/g of greater than 0.5 then the applicant's claimed amine-containing silicone compositions can not have meq/g greater than 0.5.

(11) Related Proceeding(s) Appendix

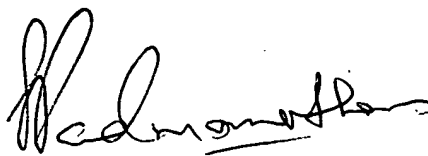
No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

Sreenivasan Padmanabhan



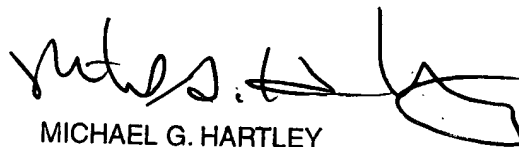
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